

## REMARKS

Claims 171-174, 184-198, 200-204, 214-215, 218-222, 227-236, 243-245, 251-255, and 260-293 are pending in the application. Claims 171, 184, 189, 200, 214, 215, 218, 221, 227, 234-236, 243-245, 251, 260, and 289 have been amended. No new matter has been entered. The Applicants respectfully request that the amendments be entered. Reconsideration of the claims in view of the following remarks is respectfully requested.

### 35 U.S.C. § 103(a) Rejection

All of the independent claims of the pending application are directed to devices that denominate that is, devices that can determine the denomination of bills, *e.g.*, is a bill a \$1 bill, a \$5 bill, etc. *See, e.g.*, independent claims 171, 184, 189, 200, 227, and 234-236 reciting, “a discriminating unit adapted to count and denominate the bills including United States bills of a plurality of denominations”; independent claim 214 reciting “a discriminating unit adapted to count and denominate the bills including bills of a plurality of denominations”; independent claim 218 reciting “the discriminating unit being adapted to count and determine the denomination of the bills”; independent claims 243, 244, and 251 reciting “a discriminating unit comprising a processor...the processor being adapted to receive the characteristic information output signal and generate a denomination signal in response thereto”; independent claim 260 reciting “a discriminating unit adapted to count and denominate the bills.”

The Office Action applied the references of De La Rue Systems 3100 Series Operator Instructions (“DLR 3100”) in view of U.S. Patent No. 5,394,992 to Winkler (“Winkler”) and U.S. Patent No. 4,592,090 to Curl (“Curl”). The Applicants respectfully traverse this rejection.

As previously discussed, DLR 3100 discloses a currency sorter or counter – not a currency evaluation device that is capable of denominating bills. In other words, the currency sorter of DLR 3100 cannot, for example, determine that a \$5 U.S. bill is a \$5 bill and a \$10 U.S. bill is a \$10 bill. Furthermore, as acknowledged in the previous Office Action, DLR 3100 does not disclose “a currency sorter capable of processing bills at a rate of 800 bills a minute or more.” Independent claims 171, 184, 189, 200, 227, and 234-236 recite, *inter alia*, a discriminating unit that is adapted to count and denominate the bills at a rate of at least 800 bills per minute.

As acknowledged in this Office Action, Winkler “fails to specifically recite a rate of denominating notes of at least 800 bills a minute.” Page 3 of the Office Action. To allegedly show such a denomination rate of notes of at least 800 bills a minute, the Office Action applies Curl. Curl, however, does not teach or suggest such a rate. Rather, Curl discloses that its “present invention relates to optical apparatus for scanning a sheet . . . The apparatus may respond to the overall condition of the note, for example the degree of soiling of the note, or it may be used for pattern recognition; for example to sort banknotes in accordance with their orientation and their denomination or Bank of Origin.” Col. 1, lines 6-13 of Curl. Curl does not disclose a rate for denominating banknotes. In fact, the only rate disclosed in Curl is in the following passage: “It is difficult to process the data in the time available between banknotes, when scanning at the rate of 20-30 notes per second (a common speed for banknote transport systems).” Col. 1, lines 39-42 of Curl. This passage, however, does not teach or suggest denominating bills at such rates. Thus, the statement in the Office Action of “such a rate [800 bills per minute] of note denomination is well known in the art” is not supported by Curl. See page 3 of the Office Action. The Applicants disagree that denominating bills at 800 bills per minute was well known in the art and respectfully request that the Examiner cite a reference that supports such a statement. See MPEP 2144.03.

Thus, it would not have been “obvious to one of ordinary skill in the art at the time of the invention to denominate bills via the Winkler apparatus at a rate of at least 800 bills per minute to provide a desirable bill-processing rate.” See page 3 of the Office Action.

Furthermore, the Applicants believe that the combinations of, for example, (a) DLR 3100 and Winkler; and (b) DLR, Winkler, and Curl are improper and reserve the right to address such combinations or other combinations if the rejections are not withdrawn. For example, the Office Action has not provided any teaching or suggestion that the device of DLR 3100 could be combined with the device of Winkler to sort documents at a rate approaching 2,000 documents/min, let alone to denominate bills at a rate of 800 bills/min. Additionally, Curl does not address such a deficiency.

Additionally, DLR 3100 does not disclose several other features that are recited in many of the independent claims such as a processor that is programmed to flag no call bills. See, e.g., independent claims 171, 184, 200, 214, 227, 243, 244, and 260. In fact, the feature of flagging

no call bills cannot be performed unless one is denominating the currency bills. Therefore, DLR 3100, which does not denominate bills, cannot teach or suggest such features recited in, for example, independent claims 171, 184, 200, 214, 227, 243, 244, and 260.

In an apparent response to a further deficiency of DLR 3100, the Office Action states that:

Regarding the Applicant's [sic, Applicants'] feature of flagging 'no calls' bills, Winkler teaches a document sorter having an operation that included the 'separation of a 'rogue' note of a different denomination from a stack of notes' (column 5, lines 20 plus). Accordingly, the separated rogue note of Winkler reads on the Applicant's [sic, Applicants'] no call bill.

See page 3 of the Office Action. The Applicants respectfully disagree. In this cited passage, Winkler is discussing "stranger" bills as that term is used in the present invention. See *e.g.*, page 30 of the present application defining "stranger" and "no-call" bills. Thus, Winkler does not disclose the feature of a processor that is programmed to flag no call bills that are disclosed in several independent claims.

Therefore, for at least these reasons, independent claims 171, 184, 189, 200, 214, 218, 227, 234-236, 243, 244, 251, and 260 are not obvious in view of DLR 3100, Winkler, Curl, or any combination thereof. Thus, independent claims 171, 184, 189, 200, 214, 218, 227, 234-236, 243, 244, 251, and 260 should be allowable. Dependent claims 172-174, 185-188, 190-198, 201-204, 215, 219-222, 228-233, 245, 252-255, and 261-293, which depend either directly or indirectly on independent claims 171, 184, 189, 200, 214, 218, 227, 244, 251, or 260 are not obvious in view of DLR 3100, Winkler, Curl, or any combination thereof for at least the same reasons and, thus, should be in a condition for allowance.

#### Comments on Selected Issues in the Office Action

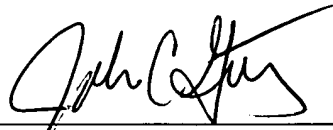
The Applicants also will not be addressing the other references mentioned at page 4 as these references have not been applied in the Office Action. The Applicants, however, note that none of these references anticipates or renders obvious the pending claims.

#### Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. A check in the amount \$110.00 is enclosed for the one-month extension of time. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized

to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00262USC2.

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